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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,047	06/11/2001	Akira Oomori	35.G2819	2412
5514	7590	09/29/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			LEE, TOMMY D	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/877,047

Applicant(s)

OOMORI, AKIRA

Examiner

Thomas D. Lee

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 12, 2005 has been entered.

### ***Response to Amendment***

2. This Office action is responsive to applicant's amendment filed September 12, 2005. Claims 30-40 are pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39 and 40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims, which recite functional descriptive material comprising a computer program, must be embodied on a *computer readable medium* to impart its functionality (MPEP 2106.IV.B1(a)). Currently, a computer readable medium is not recited in the claims.

### ***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 2624

5. Claims 31-38 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,361,143 (Nakayama et al., hereinafter Nakayama).

Regarding claims 31-34, Nakayama discloses an image processing apparatus comprising: an image reading unit adapted to read a document image (multi-color original reading means 1 (Fig. 1)); a file creating unit adapted to create a file in a memory, wherein the file can be selected by a user for transmitting the image data in the file (P file stores integrated data, data for blue color and those for a red color (column 4, lines 47-48; Figs. 2-a and 2-b)); and a controller adapted to register the document image which was read by said image reading unit both as a color image data and as monochrome image data in the file which was created by said file creating unit (in multi-color mode, black (monochrome) data and color data read and stored (column 4, lines 26-48); in monochrome mode, only black data read and stored (column 4, lines 49-55)). The image processing apparatus further comprises a transmission unit adapted to transmit image data to a destination apparatus, wherein said controller reads out one of the color image data to a destination apparatus, wherein said controller reads out one of the color image data and the monochrome image data stored in the file, which is suitable for the destination apparatus, and controls said transmission unit to transmit the read out image data to the destination apparatus (when other party is capable of multi-color printing, integrated data and data of each color transmitted (column 4, line 67 – column 5, line 3); otherwise, either only integrated data or monochrome data are transmitted (column 5, lines 21-28)); and a determining unit adapted to determine whether a document is one of a color document and a

Art Unit: 2624

monochrome document (in automatic color selection mode, color contained in original identified through prescanning (column 4, lines 11-19)), wherein, when said determining unit determines that the document is a color document, said controller registers the document image both as the color image data and as the monochrome image data in the file, and when said determining unit determines that the document is a monochrome document, said controller registers the document image as the monochrome image data in the file (storage of both types when multi-color mode is judged (column 4, lines 26-48); storage of monochrome data in monochromatic mode (column 4, lines 49-55)). Said image reading unit continuously reads image data for a plurality of documents (continuous scanning and storage until last page is reached (column 4, lines 56-61)).

Regarding claims 35 and 36, Nakayama discloses an image transmitting apparatus comprising: a memory adapted to store a document image as image data in a plurality of formats in a file (P file stores integrated data, data for blue color and those for a red color (column 4, lines 47-48; Figs. 2-a and 2-b)); a file selection unit adapted for a user to select at least one of a plurality of files in said memory (color mode setting switch on operating unit (column 4, lines 20-23)); a controller adapted to read out the image data, in a format suitable for a destination apparatus, from the file which was selected by a user through said file selection unit (when other party is capable of multi-color printing, integrated data and data of each color transmitted (column 4, line 67 – column 5, line 3); otherwise, either only integrated data or monochrome data are transmitted (column 5, lines 21-28)); and a transmitting unit adapted to transmit the image data read out by said controller to the destination apparatus (communication

Art Unit: 2624

means 3 (Fig. 1)). Said memory stores the document image both as color image data and monochrome image data in the file (column 4, lines 40-48).

Regarding claim 37, Nakayama discloses a control method for an image transmitting apparatus which comprises an image reading unit adapted to read a document image, said method comprising the step of creating a file in a memory, wherein the file can be selected by a user for transmitting the image data in the file (P file stores integrated data, data for blue color and those for a red color (column 4, lines 47-48; Figs. 2-a and 2-b); color mode setting switch on operating unit (column 4, lines 20-23)), and registering the document image which was read by said image reading unit both as color image data and as monochrome image data in the file (column 4, lines 40-48).

Regarding claim 38, Nakayama discloses a control method for an image transmitting apparatus which comprises a memory adapted to store a document image as image data in a plurality of formats in a file, said method comprising the step of reading out, from the said file when selected by a user, the image data in a format suitable for a destination apparatus and transmitting the read out image data to the destination apparatus (when other party is capable of multi-color printing, integrated data and data of each color transmitted (column 4, line 67 – column 5, line 3); otherwise, either only integrated data or monochrome data are transmitted (column 5, lines 21-28)).

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama.

Claims 39 and 40 recite a program storage medium storing a program for performing the steps of above-rejected claims 37 and 38, respectively. While Nakayama does not disclose a program storage medium, it is generally well known to one of ordinary skill in the art that processing steps are commonly stored as a program in a memory disk, or the like, to be read by a central processing unit of an apparatus, and it would have been obvious to provide a program storage medium in Nakayama, so as to enable the apparatus to perform the processing steps.

***Response to Arguments***


8. Applicant's arguments filed in response to the rejection of now-canceled claims 18-30 as set forth in the prior Office action have been fully considered but they are not persuasive. Applicant alleges that the invention as claimed in claims 31, 35, 37, 38, 39 and 40 is not disclosed or suggested by Nakayama, but does not provide any evidence to support such an allegation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

Art Unit: 2624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee  
Primary Examiner  
Art Unit 2624

tdl  
September 27, 2005